

Remarks

This Application has been carefully reviewed in light of the Final Office Action mailed March 9, 2009. Although Applicant believes all claims are allowable in their current form, to advance prosecution Applicant has made clarifying amendments to Claims 1 and 17. These amendments are not considered narrowing or necessary for patentability. Applicant respectfully requests reconsideration and allowance of all pending claims.

I. The Claims Recite Patentable Subject Matter

The Examiner rejects Claims 1, 4-9, 12-17, 20-22, 24-28, and 31-36 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses these rejections.

Regarding independent Claims 1 and 17 and their dependent claims, the Examiner states, “Although the claims 1, 3-8, 17, 20-21 and 24-27 recite a ‘method,’ it is unclear whether the method is necessarily tied to any computer hardware, thereby defining a statutory processing,” citing *In re Bilski* as support for this statement.¹ Although Applicant believes independent Claims 1 and 17 and their dependent claims recite patentable subject matter as written, to advance prosecution, Applicant has made clarifying amendments to independent Claims 1 and 17.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and 17 and their dependent claims.

Regarding Claims 9 and 12-16, the Examiner argues, “The 112 sixth paragraph has been invoked. However, it appears that the specification does not provide a physical hardware to process the means as claimed. Therefore, the claims fail to satisfy the requirements within the meaning of 101.” *Final Office Action* at 3. This is the first time the Examiner has raised this particular reasoning as a ground for rejecting Applicant’s claims under 35 U.S.C. § 101. In any event, Applicant’s Specification plainly provides example means for performing the functions recited in the claims. Applicant’s Specification is replete with description of electronic directories, databases, processing operations, the X.500 and

¹ Applicant notes that dependent Claim 3 has been canceled for some time.

LDAP standards, SQL, and a computer program product including computer usable medium having computer readable program code and computer readable system code embodied on the medium. These disclosures make clear to one of ordinary skill in the art that embodiments of the present invention may be implemented using one or more computer components.²

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 9 and its dependent claims.

Regarding Claim 28, the Examiner states the following:

Applicant has failed to provide antecedent basis for the claim terminology “one or more memory modules and one or more processing units.” A physical hardware is not an element of the claimed system. After further review [of] the specification it is evident that the system would suggest to one of ordinary skill that all may be reasonable implemented as software routines. Therefore, the claims are rejected as a system of software per se, for failing to fall within a statutory category of invention. Applicant is advised to show how the means-plus-function is read into the specification.

Final Office Action at 3-4.

First, as discussed above, Applicant’s Specification is replete with description of electronic directories, databases, processing operations, the X.500 and LDAP standards, SQL, and a computer program product including computer usable medium having computer readable program code and computer readable system code embodied on the medium. These disclosures make clear to one of ordinary skill in the art that embodiments of the present invention may be implemented using one or more computer components. One or more of these descriptions plainly provide support for the claimed “one or more memory modules and one or more processing units.” It is difficult to fathom how one of ordinary skill in the art could read Applicant’s Specification and draw any conclusion other than that Applicant’s claimed invention may be implemented using a computer system having one or more processing units and one or more memory units. Furthermore, although the Examiner’s rejection is under 35 U.S.C. § 101, Applicant notes that to comply with the written

² Applicant notes that the example means cited by Applicant are for illustrative purposes only in responding to this rejection under 35 U.S.C. § 101, and are not intended, and should not be used, to limit Applicant’s claims. Applicant’s claims should be construed according to the governing principles of applicable statutes and case law.

description requirement, “[t]he subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement.” M.P.E.P. ch. 2163.02. In other words, there is no requirement that the claims use the exact terms as the Specification. Applicant further notes that these amendments were presented as part of an Examiner’s amendment and thus were made at the Examiner’s own suggestion.

Additionally, Applicant respectfully submits that the Examiner’s comments regarding possible implementation of the system as software are irrelevant. Claim 28 plainly recites that the system comprises one or more memory modules and one or more processing units. Therefore, the claimed system comprises hardware elements. Moreover, to the extent that portions of the invention include or are otherwise implemented using software, and to the extent that Applicant’s claims can be interpreted as being directed to software, claims directed to software are statutory pursuant to Federal Circuit authority. *See Eolas Technologies, Inc. v. Microsoft Corp.*, 399 F.3d 1325, 1338-39 (Fed. Cir. 2005) (“[A]n invention includes ‘any new and useful process, machine, manufacture or composition of matter.’ Without question, software code alone qualifies as an invention eligible for patenting under these categories, at least as processes.” (citations omitted)); *see also In re Bilski*, 545 F.3d 943, 960 n.23, 88 U.S.P.Q.2d 1385, 1395 and 1399 n.23 (Fed. Cir. 2008) (“[W]e decline to adopt a broad exclusion over software or any other such category of subject matter beyond the exclusion of claims drawn to fundamental principles set forth by the Supreme Court.”)

Finally, it is unclear to Applicant what the Examiner means by the statement “Applicant is advised to show how the means-plus-function is read into the specification.” First, Claim 28 does not even include any “means-plus-function” limitations. Second, it is unclear what the Examiner means by reading a means-plus-function limitation into the Specification, and how doing so relates to this rejection of Claim 28.

For at least these reasons, Applicants respectfully request reconsideration and allowance of Claim 28 and its dependent claims.

Regarding Claims 1, 9, 17, 28, and 36, the Examiner argues that “there is no end result under the condition when the determination is made that the filter item comprises a NOT connective and a type filter item.” *Final Office Action* at 4. According to the Examiner, “Applicant should duly note that the Specification requests that both conditions be satisfied in order to process the database service query. Therefore, the claims fail to fall within a statutory category.” *Id.*

First, Applicant and the Examiner have already addressed this very issue in prior communications, and the claims were subsequently allowed. *See, e.g., Office Action* mailed 4/11/07 at 4; *Applicant’s Response* mailed 7/11/07 at 12-14; *Final Office Action* mailed 10/11/07 at 2-4; *Applicant’s Response to Final* mailed 12/11/07 at 8-10; *Applicant’s Pre-Appeal Brief Request for Review* mailed 3/11/08 at 3-4; and *Notice of Panel Decision* mailed 4/3/08. After the *Notice of Panel Decision*, this issue was not raised again by the Examiner. Applicant respectfully submits that revisiting previously-resolved issues plainly thwarts the goal of compact prosecution.

Second, Applicant does not necessarily agree with or acquiesce to the Examiner’s assertion that “the Specification requests that both conditions be satisfied in order to process the database service query.” The fact that Applicant’s Specification may disclose an example embodiment in which certain operations or possible outcomes may be described or performed does not require Applicant’s claims to recite each and every operation or possible outcome. As Applicant stated the first time this rejection was presented, the Examiner essentially is requiring the claims to recite each possible outcome of the determinations made in Claim 1 (for example) for the claim to be statutory. The Examiner has provided no support for this requirement in the current Office Action. Therefore, Applicant submits that the claims are directed to patentable subject matter.

Although the Examiner’s argument is difficult to follow, it appears that the Examiner alleges that the Claim 1, for example, is inconsistent with Applicant’s Specification. *See Final Office Action* at 4-5. Respectfully, Applicant’s Specification plainly describes the language used in Claim 1. For example, the Specification states the following:

If the filter item with a *NOT connective* is a *type only filter item* then a *logical methodology* can be utilized to evaluate or process the filter item which avoids a NOT in the SQL. The *logical methodology* may be a subtraction method expressed in expression 117 below or any other suitable methodology capable of *expanding an expression so that the filter item does not contain NOT connectives*.

Specification at 12:7-11 (emphasis added); *see also, e.g., Specification* at 15:13-17. The cited portion of the *Specification* provides just one example instance where the *Specification* supports the claimed limitation that “if a determination is made that the filter item comprises a *NOT connective* and a *type only filter item*, applying, using the computer, a *logical methodology* to evaluate the filter item, the logical methodology comprising *expanding an expression of the filter item so that the filter item does not comprise the NOT connective*,” as recited in Claim 1 as amended. Respectfully, Applicant does not agree that the claims are inconsistent with Applicant’s *Specification*.

The Examiner provides much discussion but cites no authority, let alone authority supporting his position. For example, the Examiner states that it is “absolutely necessary to add claims 4-6 into independent claim 1; claims 12-14 into independent claim 9; claims 24-25 into independent claim 17; and claims 31-33 into independent claims 28 and 36 in order to define an actual solution of the optimization problem, it is necessary to arrive, within the claims, at a final SQL statement representing the complete transformation of the directory search query into SQL, i.e. including the SQL.” *Final Office Action* at 5-6. The Examiner provides no authority for requiring Applicant to amend the claims in the manner suggested by the Examiner. Applicant is not aware of any requirement that the claims recite each step of a method described in the specification simply to be directed to patentable subject matter. If the Examiner maintains this ground of rejection, Applicant respectfully requests that the Examiner provide authority allegedly supporting the Examiner’s position.

Furthermore, it is unclear to Applicant how any of the Examiner’s comments regarding Claims 1, 9, 17, 28, and 36 lead to a conclusion that the claims “fail to fall within a statutory category,” as asserted by the Examiner. *Final Office Action* at 3.

Applicant also notes that Applicant does necessarily agree with or acquiesce to any characterization of Applicant's claims or Specification, such as those characterizations included at pages 4-6 of the Final Office Action.

For at least these reasons, Applicant respectfully requests reconsideration and allowance of independent Claim 1 and its dependent claims. For at least certain analogous reasons, Applicant respectfully requests reconsideration and allowance of independent Claims 9, 17, 28, and 36 and their dependent claims.

II. No Waiver

All of Applicant's arguments and amendments are without prejudice or disclaimer. Additionally, Applicant has merely discussed example distinctions from the references cited by the Examiner. Other distinctions may exist, and Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. By not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner's additional statements. The example distinctions discussed by Applicant are sufficient to overcome the Examiner's rejections.

Conclusion

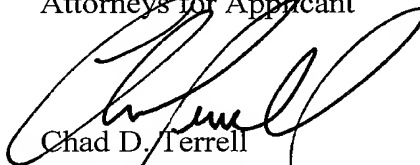
Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all pending claims.

If the Examiner feels that a telephone conference would advance prosecution of this Application in any manner, the Examiner is invited to contact Chad D. Terrell, Attorney for Applicant, at the Examiner's convenience at (214) 953-6813.

As indicated on the accompanying RCE Transmittal form, the Commissioner is hereby authorized to charge the amount of \$810.00 to Deposit Account No. 02-0384 of Baker Botts L.L.P. to cover the cost of the RCE fee. Additionally, as indicated on the accompanying Request for Extension of Time, the Commissioner is hereby authorized to charge the amount of \$130.00 to Deposit Account No. 02-0384 of Baker Botts L.L.P. to cover the fee for a one-month extension of time. Although Applicant believes no other fees are due, the Commissioner is hereby authorized to charge any additional fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

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